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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,306	12/21/2001	Oliver Jud	JUD	6535

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EXAMINER

PANTUCK, BRADFORD C

ART UNIT	PAPER NUMBER
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3731

4

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,306

Applicant(s)

JUD ET AL.

Examiner

Bradford C Pantuck

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 26, 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 4-17, 21, and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on December 21, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 4-17, 21, and 22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 3.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear, specifically, whether the probe includes the hollow needle only or the hollow needle and the rod.
3. Claim 2 recites the limitation "said optical guide" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,486,185 to Freitas et al. Regarding Claim 1, Freitas discloses a micro

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(able to fit into small places) surgical cutting instrument [Column 3, lines 32-35] configured as a scissors [Column 2, lines 30-33], including all of the claimed features. With reference to Figure 3, Freitas' instrument has a housing (50) configured as a handle and a sliding device (82) disposed inside of it. The housing (50) is used as a handle, as is evident by its shape, which resembles a handle of a gun.

Sliding device (82) slides within the housing (50), pushing the probe (68) distally towards the tip of cutting members (248 and 250) [Column 4, lines 61-64]. There is a rod (52) inside of the probe (68), sharing the same central axis [Fig. 3]. The probe (68) could be called a "hollow needle". One of the configurations disclosed is one in which scissors with two cutting members having a straight configuration. The scissors piece is shown in Figure 9 and described in Column 7, lines 7-13. The two blades (252) make an acute angle, and when the probe (69) is extended distally in the direction of the tip of the cutting members (248 and 250), the cutting edges (252) engage each other [Column 7, lines 25-27 and Column 4, lines 61-63] to establish a cutting action. The various "heads", i.e. scissors, clamp, etc...are interchangeable in the different embodiments [Column 7, lines 38-40].

5. Regarding Claim 20, Freitas discloses using his surgical scissors as being for use in laparoscopic surgery, in which his scissors are inserted into a body cavity [Column 1, lines 24-54].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 3, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,486,185 to Freitas et al. in view of U.S. Patent No. 6,066,102 to Townsend et al. Freitas discloses laparoscopic cutting instrument according to claim 1, as described above. Regarding Claim 2, Freitas discloses using his device with an endoscope “fiberoptic bundle” [Column 1, lines 41-44], but Freitas does not disclose an optical viewing means positioned *within his device*. However, Townsend discloses another laparoscopic cutting instrument and teaches that an optical fiber (900) [see Fig. 3] ought to be *wired coaxially with the cutting scissors* so that the biopsy (cutting) is performed at exactly the right spot. Townsend explains that prior art devices had employed either separated optical viewing systems [Column 1, lines 52-60], or optical viewing systems that were off center [Column 1, line 67—Column 2, line 6], and both of these procedures led to inaccurate surgeries. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to use a light guide (optical guide) coaxially disposed within the tube-shaped probe (68) of Freitas in order to aid the surgeon in performing an accurate incision, as taught by Townsend.

7. Regarding Claims 3 and 18, Townsend’s optical fiber system necessarily employs a monitor for showing the doctor the image captured by the distal end of the optical guide. It is well known that this is how an optical system works. Without such a screen, what would be the use of having an optical light guide? Additionally, without

providing light, how could the surgeon see the tissue site inside of the body?

Regardless, Townsend makes reference to U.S. Patent No. 5,439,000 to Gunderson et al. [Column 1, lines 43-46], which shows the entire viewing system including a monitor (82) and a light source (30) [see Figure 5]. It is the viewing system such as that of Gunderson that Townsend uses in his invention [Column 1, lines 42-45].

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,486,185 to Freitas et al. in view of U.S. Patent No. 5,047,008 to de Juan, Jr. et al. Freitas discloses microsurgical scissors intended for use in various locations inside of the body [Column 1, lines 24-40], but not specifically for use in the eye. However, de Juan, Jr. also discloses microsurgical scissors [Column 2, lines 32-35] and teaches that one ought to perform laparoscopic surgery on the vitreous humor in order to remove the vitreous from the eye in the treatment of disease [Column 1, lines 23-40]. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to use Freitas' microsurgical scissors to perform a vitrectomy, in order to treat disease in the eye, as taught by de Juan, Jr. et al.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent No. 5,439,000 to Gunderson et al.

U.S. Patent No. 4,027,510 to Hildebrandt (laparoscopic surgery with outer sleeve that closes the jaws)

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U.S. Patent No. 6,051,011 to Weidenbenner (teaches that it is well known to use a viewing means with a cutter)

U.S. Patent No. 5,810,877 to Roth et al.

U.S. Patent No. 4,433,687 to Burke et al.

U.S. Patent No. 4,108,211 to Tanaka

U.S. Patent No. 5,429,121 to Baum et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (703) 305-8621. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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February 24, 2004


MICHAEL J. MILANO
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